

JUN 14 2004

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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

		Application Number	10/654,790
		Filing Date	09/04/2003
		First Named Inventor	Pan, Janet L.
		Group Art Unit	2818
		Examiner Name	N/A
Total Number of Pages in This Submission	8	Attorney Docket Number	Y0165-002

## ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input checked="" type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		
Remarks		

Return Postcard

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	David Garrod (Reg. No. 35,149)
Signature	
Date	06/14/2004

## CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: \_\_\_\_\_

Typed or printed name		
Signature		Date

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



06/16/04

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JUN 14 2004

Attorney Docket No.: Y0165-002

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Pan, Janet L.  
Group Art Unit: 2818  
Serial No.: 10/654,790  
Filing Date: 09/04/2003  
Examiner: N/A  
Title: Use of Deep-Level Transitions in Semiconductor Devices

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Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

EXPRESS MAIL CERTIFICATE

Express Mail Label No.: EL 616520257 US      Date of Deposit: June 14, 2004

I hereby certify that the following documents:

1. Transmittal Form (1 Page);
2. Renewed Petition to Correct Filing Date and Supporting Exhibits (8 Pages); and
3. Return Postcard

are being deposited with the United States Postal Service "Express Mail Post Office To Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to, Assistant Commissioner for Patents, Box Patent Application, Washington, D.C. 20231.

Respectfully Submitted,

Shannon Travis  
Shannon Travis

Mailing Address:  
PATTERSON, BELKNAP, WEBB & TYLER LLP  
1133 Avenue of the Americas  
New York, NY 10036-6710  
Telephone: (212) 336-2000  
Facsimile: (212) 336-2222



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

To: Please deliver to Paul Shanoski, c/o Office of Petitions

In re: Application of Janet L. Pan

5

For: USE OF DEEP-LEVEL TRANSITIONS IN SEMICONDUCTOR DEVICES

Filed: 9/4/03

10 S/N: 10/654,790

RENEWED PETITION TO CORRECT FILING DATE

Sir/Madam:

15

Applicant respectfully renews its petition to correct the filing date in response to the Decision on Petition Under 37 C.F.R. §1.53 (copy attached as Ex. A), mailed 4/14/2004, in the above-identified application.

20 In refusing to correct the filing date, the Office noted that applicant had not submitted copies of both sides of the original return postcard. Accordingly, applicant hereby submits copies of both sides of the return post card, both as filed (attached Ex. B) and as returned (attached Ex. C). In 25 light of this additional evidence, applicant respectfully requests that the Office reconsider the petition.

Respectfully submitted,

30 Patterson, Belknap, Webb & Tyler, LLP

Dated: 6/14/2004

By:

A handwritten signature in black ink that appears to read "David Garrod".

\_\_\_\_\_  
David Garrod (Reg. No. 35,149)

35

1133 Avenue of the Americas  
New York, NY 10036-6710  
Tel. 212-336-2183



UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. None

Patterson, Belknap, Webb & Tyler LLP  
ATTN: IP Docketing  
1133 Avenue of the Americas  
New York NY 10036

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APR 14 2004

OFFICE OF PETITIONS

In re Application of  
Janet L. Pan  
Application No. 10/654,790  
Filed: September 4, 2003  
Attorney Docket No. Y0165-002  
Title: USE OF DEEP-LEVEL  
TRANSITIONS IN SEMICONDUCTOR  
DEVICES

: DECISION ON PETITION  
: UNDER 37 C.F.R. §1.53(e)

BACKGROUND

This is a decision on the "petition to correct filing date," which is properly treated as a petition pursuant to 37 C.F.R. §1.53(e), filed January 26, 2004, requesting the application be accorded a filing date of September 4, 2003 with Figure 16 considered part of the original disclosure.

The application was deposited on September 4, 2003. However, on November 25, 2003, the Office of Initial Patent Examination (OIPE) mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (Notice), stating that the application appeared to have been deposited without Figure 16. The notice further indicated that an executed oath or declaration and the surcharge associated with the late filing of an oath or declaration were required.

In response, on January 26, 2004, applicants filed the present petition. Applicants request that the application, including Figure 16, be accorded a filing date of September 4, 2003. Petitioner has included the following four submissions in an attempt to have this figure accepted as present on filing:

DOCKETED 4/20  
ST

- A statement that Applicant's copy of the "9/4/03 filing papers<sup>1</sup>" contains the missing figure
- A statement that Applicant's copy of the "9/4/03 filing papers<sup>2</sup>" contains both an Express Mail certificate and a return postcard, both of which make reference to the missing figure
- A copy of the Express Mail label
- A copy of applicants' postcard receipt which properly itemizes "Drawings - 16 sheet(s)/Figs. 1 to 16."

Receipt of the declaration and the surcharge associated with the late filing of the same is acknowledged.

THE RELEVANT PORTIONS OF THE CODE OF FEDERAL REGULATIONS AND MPEP

37 C.F.R. § 1.8 sets forth, in part:

§ 1.8 Certificate of mailing or transmission.

- (a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.
- (1) Correspondence will be considered as being timely filed if:
- (i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:
- (A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or
- (B) Transmitted by facsimile to the Patent and Trademark Office in accordance with §1.6(d); and
- (ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.
- (2) The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on, the following:
- (i) Relative to Patents and Patent Applications –
- (A) The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an

1 Petition, page 1.

2 Id.

application filing date, including a request for a continued prosecution application under §1.53(d);

Section 503 of the MPEP, entitled Application Number and Filing Receipt, sets forth, in part:

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference, etc., title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.

Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO.

(emphasis added)

### ANALYSIS

The argument and evidence submitted is not persuasive.

With regards to the first submission, the Patent Office file is the official record of the papers originally filed in this application. A review of the official file reveals that Figure 16 was not included on filing. The PTO file is the official record of the papers originally filed in this application. Unfortunately, the papers which Petitioner has in his personally, the ~~file~~ are not relevant.

Regarding the first portion of the second submission, the Express Mail certificate cannot be used to establish that a 'drawing' was received in the Office, pursuant to 37 C.F.R. §1.8(a)(2)(i)(A), reproduced above.

Regarding the third submission, an Express Mail label can be used to establish that an application was deposited with the United States Postal Service on a particular date for the purposes of establishing the date of deposit as the filing date, pursuant to 37 C.F.R. §1.10. However, 37 C.F.R. §1.10 cannot be used to establish that a particular item was included on filing.

Regarding both the second portion of the second submission and the fourth submission, it is noted that the postcard does not contain a date stamp<sup>3</sup>. As such, it cannot serve as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped on the postcard. Therefore, Petitioner's postcard receipt cannot constitute persuasive evidence.

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<sup>3</sup> Perhaps the date stamp was placed on the reverse side of the postcard? All that was provided was a copy of the front of the postcard.

CONCLUSION

For these reasons, the petition must be DISMISSED.

Any response must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The response should include a cover letter entitled "Renewed Petition under 37 CFR 1.53(e)."

The reply to this letter may be submitted by mail<sup>4</sup>, hand-delivery<sup>5</sup>, or facsimile<sup>6</sup>.

The reply should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner. The Petitioner may wish to consider telephoning the undersigned at the number provided below to confirm that the documents were delivered to the undersigned. Please note that the delivery process within the PTO can take as much as three weeks.

The application file will be retained in the Office of Petitions for two (2) months. The petition is Granted.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0011.



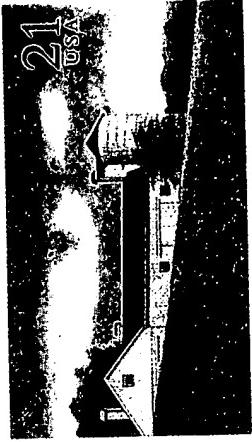
**Paul Shanoski  
Senior Attorney  
Office of Petitions  
United States Patent and Trademark Office**

<sup>4</sup> Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

<sup>5</sup> Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

<sup>6</sup> (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned.

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PATTERSON, BELKNAP, WEBB & TYLER LLP  
1133 AVENUE OF THE AMERICAS  
NEW YORK, N.Y. 10036

ATTN: IP DEPT.  
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Serial No. N/A Filing Date Feb 16 2001 File No. Vol165-002  
THE USE OF DEEP-LEVEL TRANSITIONS IN SEMICONDUCTOR DEVICES

Applicant: Mart L. Dan Date \_\_\_\_\_  
The PTO has received: \_\_\_\_\_ Last Due Date: \_\_\_\_\_

Patent Application of 75  TM Application  ITU Basis  
 Pages (including claims & abstract)  Statement of Use  
 Declaration or  Designation Sheet  Extension of Time  
 Drawings 16 Sheet(s)/Figs. 1 to 16  Notice of Appeal  
 Priority Document  Brief  
 Small Entity Declaration  Petition  
 Assignment & Conveyance Cover Sheet  Status Request  
 Information Disclosure Statement  Issue Fee  
 PTO-1449  Affidavit of Use  
 Amendment  Renewal  
 Affidavit or Declaration  Certificate of Mailing  
 Express Mail No. EV 265498245 US  
 Check No. 30492 for \$ 375.00  Return Post card  
TR-1 CT

# BEST AVAILABLE COPY

Serial No. N/A Filing Date Filed herewith File No. Y0165-002  
Title THE USE OF DEEP-LEVEL TRANSITIONS IN SEMICONDUCTOR DEVICES

Applicant: Janet L. Pan Date                         

The PTO has received:

- Patent Application of 75  
Pages (including claims & abstract)  
 Declaration or  Designation Sheet  
 Drawings 16 Sheet(s)/Figs. 1 to 16  
 Priority Document  
 Small Entity Declaration  
 Assignment & Conveyance Cover Sheet  
 Information Disclosure Statement  
 PTO-1449  
 Amendment  
 Affidavit or Declaration

Check No. B0492 for \$ 375.00

Atty/Secy DG/ST

Last Due Date: \_\_\_\_\_

- TM Application  ITU Basis  
 Statement of Use  
 Extension of Time  
 Notice of Appeal  
 Brief  
 Petition  
 Status Request  
 Issue Fee  
 Affidavit of Use  
 Renewal  
 Certificate of Mailing  
 Express Mail No. EV 265498245 US

Return Postcard

22264 U.S.P.T.O.  
10/654790  
09/04/03

PTO STAMP



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NEW YORK, N.Y. 10036

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